

REMARKS

This Response is filed in reply to Advisory Action dated September 16, 2009.

Summary of Advisory Action

The Advisory Action indicates that the Amendment Under 37 C.F.R. § 1.116 filed August 12, 2009, was not entered because the amendments to the claims raise issues that would require further consideration and/or search. In this respect, the Examiner asserts that the claim amendments raise the issue of new matter.

Accordingly, the Examiner asserts that the claim amendments do not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Specifically, the Examiner appears to assert even “though Applicant had possession of a composition that is “the combination of theanine, genisteine, L-carnitine, (added) catechin, and caffeine”, such a combination is an embodiment that was not specifically described in this manner in the originally filed the specification. Also, Applicants’ arguments that the rejections under 35 U.S.C. § 103 are obviated is not persuasive, because the claim amendments will not be entered.

With regard to Applicants’ arguments regarding Spiegel and Ingram, the Examiner has found these arguments to not be persuasive because one of ordinary skill in the art is provided with ample instruction and motivation to combine the claimed ingredients such as theanine, genisteine, L-carnitine, and caffeine to produce a composition with a slimming effect. The Examiner asserts that both Spiegel and Ingram are directed toward a formulation for suppressing weight gain, so that the claimed components have been previously taught to be used in a composition with a slimming effect. The Examiner appears to conclude that one of ordinary skill in the art would have obtained the claimed invention based upon the teachings of the references.

**Amendment under 35 U.S.C. § 1.116 does not raise a new issue
requiring new consideration or new search**

Initially, the Examiner's statements in the Advisory Action was not clear to Applicants. However, Applicants believe the Examiner is asserting that the claimed combination of theanine, genisteine, L-carnitine, (added) catechin, and caffeine as an anti-cellulite composition to reduce the activity of glycerol-3-phosphate dehydrogenase (GPDH) raises new issue which requires new consideration or search. In this respect, Applicants disagree with the Examiner for the following reasons.

As previously argued, Examples 7 and 8 at pages 18-19 explicitly disclose the slimming and firming effect of the "[s]limming/anti-cellulite lotions" of Examples 1~8 (see page 16 and Table 3)¹ in comparison to comparative Examples 1 and 2 (see Table 4 at page 17). The slimming effect of the compositions of Examples 1~8 are shown in Figure 6, in which Example 1 "containing all the 5 effective components showed the most significant effect" (see page 18, lines 18-19). In addition, "Example 1 containing the effective components showed the [most significant] increased skin firmness" (see page 19, lines 3-4) as evidenced in Figure 7. Also, Example 6 and Table 2 show that the combination of theanine, caffeine, genistein, L-carnitine, and catechin provide no adverse skin irritation in comparison to control vehicle (see pages 15-16).

Furthermore, page 6, lines 8-18 explicitly disclose that "the composition of the present invention has excellent effects on inhibiting differentiation of fat cells (adipocytes) and accumulation of fats in fat cells...because the composition of the present invention can reduce

¹ Specifically, Example 1 of Table 3 shows a composition containing theanine, caffeine, genistein, L-carnitine, and catechin, in combination with inactive ingredients for formulating an external skin application composition.

the activity of GPDH (glycerol-3-phosphate dehydrogenase) enzyme...[t]herefore, when the composition...comprising theanine and at least one selected from the group consisting of caffeine, genistein, L-carnitine and catechin is applied to the skin, increase of body fat can be effectively inhibited by the inhibition of the generation and the enlargement of fat cells.” Thus, “the composition of the present invention can be used for external composition for anti-cellulite” (see page 6, lines 19-20). Page 7, lines 9-19 explicitly discloses that the components of theanine, caffeine, genistein, L-carnitine, and catechin may be mixed in any conventional method known in the art so that the amount of each is 0.0001~20wt% of the total weight of the composition, and for external application to reduce subcutaneous fat for a slimming effect and removing cellulite.

Accordingly, based upon the disclosure of the as-filed specification and as acknowledged by the Examiner in the Advisory Action (i.e., already considered by the Examiner), one of ordinary skill in the art would understand that Applicants were in possession of the anti-cellulite composition for external skin application consisting of L-theanine, caffeine, genistein, L-carnitine and catechin as presently claimed to reduce the activity of GPDH. Also, the patentability of the combination as recited in the Amendment under 37 C.F.R. § 1.116 was previously argued by Applicant, and thus no new issue requiring new search or consideration is required.

In particular, Applicants respectfully note that catechin has been previously argued to be an essential and material component of the claimed anti-cellulite composition (see pages 4-5 of Amendment filed April 6, 2009). Also, catechin has been previously considered by the Examiner in the examination and search for the present application, as evidenced by the reasons set forth on record for the 103(a) rejection. Thus, the claim amendments do not raise issues that would require further consideration and/or search.

Accordingly, entry and consideration of the claim amendments filed August 12, 2009 and allowance of the application are respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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